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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,852	09/26/2003	Jeyhan Karaoguz	15012US02	1267
23446	7590	07/29/2005	EXAMINER	
MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			SMITH, JEFFREY A	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,852

Applicant(s)

KARAOGUZ ET AL.

Examiner

Jeffrey A. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

The drawings filed September 26, 2003 are objected to because Figs. 1 and 2 contain improper shading; and Figs. 3-11 contain roughly drawn figure legends, reference numerals, and lead-lines.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: Applicant should provide the omitted application serial numbers for the U.S. applications listed at page 2 of the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United

States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 10, 11, 15-21, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Novak (US 2003/0097655 A1).

Regarding claims 1 and 15

Novak discloses a system (see Fig. 1) providing support for user transaction on a media exchange network (par. [0002]).

The system comprises a television display (104) for consumption of media (par. [0082]); a storage (310) for storing media (par. [0077]), and having an associated network address (par. [0049]); set top box (see Fig. 3: 102) circuitry (308) communicatively coupled to deliver media from the storage to the television display (par. [0076]); an interface device (305) for receiving from an authorization device (see Fig. 4: 410) associated with a user, information for authorizing a user transaction, the interface device communicatively coupled to the set top box circuitry (par. [0074]).

Novak further discloses (see Fig. 4) that the system comprises server software that receives, via a communication network, a request (409) comprising at least one of the

associated network address, information identifying the user transaction, and at least a portion of the information for authorizing a user transaction (pars. [0049], [0088], and [0112]), and responds by enabling the completion of the identified user transaction without divulging the identity of the user to a vendor. For example, the Examiner notes (with reference to Fig. 4) an embodiment in which the verification of identity credentials includes checking the identity credentials with a trusted third party (TTP) (par. [0090]). A license key (412) and an access key (414) is all that is needed to decrypt the digital content (pars. [0096] and [0098]). These keys are received by the set top box (see Fig. 4 and par. [0030]). The set top box receives the digital content (404) from a content source (420). The user may obtain access to digital content based on the user's license (411) stored at the verification entity (406: in this case the trusted third party). The license (411) is not tied to the user's set top box. The user may view the program using another set top box by simply inserting his or her smart card (410) and/or providing the necessary pass code, pass phrase, biometric data or the like (par. [0103]). In this manner the transaction is enabled

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without divulging the identity of the user to a vendor (either the broadcast center (110) or the sources (420) (par. [0099])).

Regarding claims 2 and 16

Novak discloses that the media comprises at least one of audio, a still image, video, real-time video, and data (par. [0082])).

Regarding claims 3 and 17

Novak discloses that consumption comprises at least one of playing audio, displaying a still image, displaying video, and displaying data (par. [0082])).

Regarding claim 4

Novak discloses that the associated network address is one of an Internet protocol (IP) address, a media access control (MAC) address, and an electronic serial number (ESN) (par. [0049])).

Regarding claims 5 and 18

Novak discloses that the communication network comprises at least one of a cable infrastructure, a satellite network

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infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and a wireless infrastructure (pars. [0052], [0053], and [0085]).

Regarding claims 6 and 19

Novak discloses that the communication network is the Internet (pars. [0057], [0060], [0084], [0085], and [0098]).

Regarding claims 7 and 21

Novak discloses that the interface device comprises one of an optical card reader, a magnetic card reader, a radio frequency identification (RFID) interface, an integrated circuit (IC) card interface, a biometric sensing device, and a cellular telephone (par. [0074]).

Regarding claims 10 and 20

Novak discloses that the user transaction comprises at least one of the storage, exchange, purchase, and consumption of media (par. [0082]).

Regarding claims 11 and 24

Novak discloses that the system further comprises a remote control communicatively coupled to the set top box (par. [0050]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8, 9, 12-14, 22, 23, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak (US 2003/0097655 A1) in view of Russell et al. (US 2004/0044627 A1).

Regarding claims 8, 9, 22, and 23

As noted above, Novak discloses an interface device communicatively coupled to the set top box circuitry (see Fig.

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4). Novak is silent as to the coupling mechanism being wired or wireless.

The Examiner notes, however, that Novak teaches that the authentication process may require the user (402) to enter additional information via the remote control (106). Such remote control may use infrared (IR), radio frequency (RF), or other wireless technologies to transmit control signals to the set top box (102) (par. [0050]). It is also noted that Novak teaches that the user may need to have current biometric data scanned by a biometric reading device, such as a fingerprint or retinal scanner, which is also sent with or following the request (409) for verification purposes (par. [0089]). Novak does not teach, however, that the biometric reading device is either integral with the remote control or that the reading device is wirelessly coupled to the set top box circuitry.

Regarding claims 12 and 25

The Examiner notes that Novak teaches that the authentication process may require the user (402) to enter additional information via the remote control (106) which communicates the user transaction authorization information to the set top box circuitry (par. [0089]). Novak, however, does

not teach that such authorization information is from an authorization device, per se. It is also noted that Novak teaches that the user may need to have current biometric data scanned by a biometric reading device, such as a fingerprint or retinal scanner, which is also sent with or following the request (409) for verification purposes (par. [0089]). Novak does not teach, however, that the remote control comprises the biometric reading device.

Regarding claims 13, 14, 26, and 27

The Examiner notes that Novak does not teach that the remote control comprises a scanning device to identify at least one of a product and a service.

Now comes Russell et al.

Russell et al. discloses a similar system providing support for user transaction on a media exchange network (see Abstract).

Russell et al. discloses a remote control in the form of a personal identifying device (PID) which is a portable device (par. [0182]) which is used to control access (par. [0060]) to entertainment systems (par. [0202]) in conjunction with applications exemplified by proprietary content browsing

(including pay television, pay audio, pay entertainment, royalty-based offerings such as ASCAP or other proprietary music offerings) (par. [0220]).

Regarding claims 8, 9, 22, and 23

Russell et al. teaches that the PID comprises a wireless coupling mechanism which comprises at least one of an infrared link (IR) and a radio frequency (RF) link (par. [0170]).

Russell et al. teaches that the PID may comprise both wired and wireless alternatives (par. [0171]).

Regarding claims 12 and 25

Russell et al. teaches that the PID comprise an interface device for receiving user transaction authorization information from an authorization device associated with a user (par. [0184]).

Regarding claims 13, 14, 26, and 27

Russell et al. teaches that the PID comprises a scanning device to identify at least one of a product and a service. The scanning device comprises one of an optical scanner and a radio frequency identification (RFID) interface (par. [0299]).

It would have been obvious to one of ordinary skill in the art to have modified the system of Novak to have included a remote control of the type and functionality taught by Russell et al. (thereby integrating the smart card reader of Novak in the disclosed remote control of Novak) in order to have provided a self contained, and portable remote control that can be carried on one's person (see Russell et al.: par. [0182]). Such self contained portability would have been especially advantageous and desirable in the scenario taught by Novak in which a person wishes to access digital content while away from their usual access location (see Novak: par. [0103]). In this scenario, it would not be necessary that the access location located away from their usual access location have an interface device associated with the access location because it would have been advantageously integrated into the portable remote control carried by the person.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wellner (U.S. Patent No. 5,640,193) discloses a multimedia service access by reading marks on an object. The invention enables a user to control the selection of electronic services to be provided to the user by one or more servers over a communication medium. The apparatus includes a scanner for reading marks on an object and for communicating a request signal. The electronic service is a multimedia program. See col. 1, lines 33-46.

Tsuria et al. (U.S. Patent No. 6,424,947 B1) discloses a distributed IRD (integrated receiver and decoder) system. The system comprises first and second smart card readers which provide restricted access to television programming and purchases (col. 2, lines 20-52).

Billmaier et al. (US 2003/0028883 A1) discloses a system and method for using user-specific information to configure and enable functions in remote control, broadcast, and interactive systems. A smart card reader may be integrated into a remote

control or a set top box (see Figs. 2A and 2B; and pars. [0030] and [0031]).

Slater et al. (WO 99/66436 A1) discloses a verified payment system. The system comprises a verified trusted-third party system (VPS) which mediates secure electronic transactions. The VPS may be implemented by any known networking configuration for any known electronic or digital transaction using, *inter alia*, digital television for any form of commerce using electronic transactions (see Abstract).


Cutino et al. (EP 1 263 230 A1) discloses a cable television payment and load system using a smart card. A set top box controls the interaction with a consumer and interfaces to a card reader which accepts a smart card (see Abstract).

Walker, Leslie: "Cloaking Devices Designed for Wary Web Shoppers"; The Washington Post [Final Edition]; Washington DC; October 19, 2000; pg. E. 01 reports on New York-based iPrivacy. iPrivacy was to test a system that would allow people to make anonymous purchases by creating a coded name, address and credit-card number that merchants would receive in place of the real information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey A. Smith
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Art Unit 3625